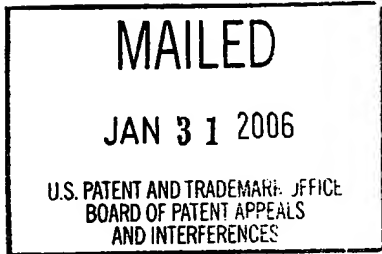


The opinion in support of the petition decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

JOSEPH C. SHER and DANIEL R. LOUGHMILLER

Appeal No. 2005-0826
Application No. 09/989,563

DECISION ON PETITION

This is a decision on the petition filed September 7, 2005 to reverse the decision denying the oral hearing or, alternatively, under 37 CFR § 1.183 to suspend or waive the requirement to timely file a request for an oral hearing in a separate paper under 37 CFR § 1.194(b).¹ This petition to reverse the decision denying the oral hearing will be treated as a petition under 37 CFR § 1.181 invoking the supervisory authority of the Director.

¹ The applicable rule is 37 CFR § 41.47(b) (2005), which recodified 37 CFR § 1.194(b) (2004) and became effective on September 13, 2004. 69 Fed. Reg. 49960 (Aug. 12, 2004), reprinted in 1286 Off. Gaz. Pat. & Tm Office 21 (Sept. 7, 2004).

Pursuant to 37 CFR § 1.181(g) and 37 CFR § 41.3, the Director has delegated authority to decide petitions under 37 CFR §§ 1.181 and 1.183 from actions of the Board of Patent Appeals and Interferences or of personnel at the Board of Patent Appeals and Interferences to the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences. MPEP § 1002.02(f)(4)(b).

The petition under 37 CFR § 1.181 to reverse the decision denying the oral hearing is DENIED.

The petition under 37 CFR § 1.183 to suspend or waive the requirement of filing the request for oral hearing as a separate paper and grant the oral hearing is GRANTED.

FINDINGS

1. On June 5, 2003, Petitioner filed a Reply Brief. On the transmittal letter attached to the Reply Brief, Petitioner includes a list of papers submitted on that day as well as instructions, including a brief statement that states: "Appellants hereby request an oral hearing."
2. On August 24, 2004, the Board entered a "Notification of Non-Compliance Regarding Oral Hearing" stating on pages 1 and 2 that:

The file record reflects that the appellants filed a Reply Brief with an amendment on June 5, 2003. On the transmittal sheet listing the various papers being submitted on that date, there was an inclusion that the appellants request an oral hearing in connection with the appeal. However, no separate paper requesting an oral hearing was found in the application file.

Effective December 1, 1997, 37 CFR § 1.194(b) was amended to provide that a request for an oral hearing must be filed in a separate paper.

Since the request for oral hearing was not filed in a separate paper as required by 37 CFR § 1.194(b), the appellants' request for an oral hearing cannot be granted. Thus, the previous notation of the Appeal being subject to an oral hearing is withdrawn.

3. On September 7, 2005, Petitioner filed the instant petition under 37 CFR § 1.181 to “reverse its decision that Appellants failed to satisfy 37 CFR § 1.194(b) and set an oral hearing date” (Petition, page 2) or alternatively, under 37 CFR § 1.183 to suspend or waive the requirement of filing the request for oral hearing as a separate paper and grant the oral hearing (Petition, paragraph bridging pages 2 and 3).

4. In support of petition under 37 CFR § 1.181, Petitioner argues that

The rule does not exclude transmittal letters as separate papers. Rule 1.194 merely specifies that the request for oral hearing must be made in a separate paper from the briefing.

Appellants made a good faith effort to satisfy this separate paper requirement. Appellants' transmittal letter *is a* separate paper pursuant to 37 C.F.R. § 1.194(b) and it requested an oral hearing (“Appellants hereby request an oral hearing”). Indeed, the Office accepted that transmittal letter as a separate paper requesting oral hearing on three different occasions and had even set an oral hearing date. There is no reason for the Office to stray from those previous decisions. Accordingly, the Office should reverse its decision that Appellants failed to satisfy 37 C.F.R. § 1.194(b) and set an oral hearing date (Petition, page 2).

5. In support of the petition under 37 CFR § 1.183, Petitioner argues that

First, Appellants are prejudiced by the Office's denial of an oral hearing Appellants have spent a lot of time and resources on this Appeal. Had Appellants known that they would not be able to argue this Appeal at an oral hearing, then Appellants may not have pursued such an Appeal. Instead, Appellants would have proceeded differently.

For example, in The Examiner's Answer, the Examiner withdrew its rejections of claims 22-24. Appellants decided to cancel these claims (“cancelled claims”) from the appeal and to

pursue them in a continuation application. Had Appellants known that there would be no oral hearing regarding the remaining claims, Appellants might have accepted the cancelled claims in The Appeal and filed a continuation application to pursue the rejected claims at issue on Appeal. Because the Office lead Appellants to believe that an oral hearing would occur, Appellants tactically decided not pursue that route. Because Appellants cannot now change course with respect to how they proceed with the claims, Appellants have been unjustly prejudiced by the Office's action.

Second, an oral hearing is necessary in this case to adequately respond to the Examiner's rejections. The claimed invention is complex and relates to intricate electrical circuits. Such circuitry is subject to the much-discussed "hindsight trap," in which the invention leads an examiner to use the applicant's own disclosure as a blueprint to defeat patentability by simply piecing together circuitry used in different settings from multiple references. However, because of the complexity of the circuitry at issue and its specific use, the Examiner incorrectly characterized the circuits disclosed in the prior art and further incorrectly combined those circuits. Similarly, the Examiner did not cite any specific motivation to combine these references, but rather relied on his own conclusory assertion of a motivation to combine. Though Appellants' briefs makes these points, Appellants' arguments could be easily misunderstood and dismissed on the papers. Thus, Appellants desire an oral hearing to specifically point out, on the circuit diagram level, the deficiencies in Examiners' assertions regarding the teachings of the prior art and any motivation to combine (Petition, page 3).

6. The pertinent portion of 37 CFR § 1.181 read as follows:

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

7. 37 CFR § 1.183 reads as follows:

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(f).

8. The pertinent portions of 37 CFR § 41.47 read as follow:

§ 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

9. The pertinent portions of Section 1209 of the Manual of Patent Examining Procedure (MPEP) read as follows:

§ 1209 Oral Hearing

37 CFR 41.47(b) provides that an appellant who desires an oral hearing before the Board must request the hearing by filing, in a separate paper captioned "REQUEST FOR ORAL HEARING," a written request therefor, accompanied by the appropriate fee set forth in 37 CFR 41.20(b)(3), within 2 months after the date of the examiner's answer or supplemental examiner's answer. Form PTO/SB/32 may be used to request an oral hearing. This time period may only be extended by filing a request under either 37 CFR 1.136(b) or, if the appeal involves an *ex parte* reexamination proceeding, under 37 CFR 1.550(c).

If the written request for an oral hearing is not filed in a separate paper captioned "REQUEST FOR ORAL HEARING," the request is improper and the appeal will be assigned for consideration and decision on the briefs without an oral hearing. Likewise, if the request is not timely filed or accompanied by the appropriate fee, the request is improper and the appeal will be assigned for consideration and decision on the briefs without an oral hearing...

DISCUSSION

Petition under 37 CFR § 1.181 to reverse decision denying oral hearing

Petitioner argues that 37 CFR § 1.194(b) does not exclude transmittal letters as separate papers and only specifies that the request for oral hearing must be made in a separate paper from the briefing (see Finding No. 4). However, 37 CFR § 41.47(b), which recodified 37 CFR § 1.194(b) and became effective on September 13, 2004 specifically requires a Request for an Oral Hearing be in the form of a separate paper captioned "REQUEST FOR ORAL HEARING" (see Finding No. 8). MPEP § 1209 offers further guidance on the format of a proper request for oral hearing by referring to Form PTO/SB/32 as illustrative of the proper format for a Requesting an Oral Hearing (see Finding No. 9). The transmittal sheet does not meet these requirements.

Accordingly, the petition under 37 CFR § 1.181 to reverse the decision denying the oral hearing is DENIED.

Petition under 37 CFR § 1.183 to Suspend or Waive the Separate Paper Requirement
of 37 CFR § 41.47(b)

37 CFR § 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee on petition of the interested party, subject to such other requirements as may be imposed (see Finding No. 6).

The requirement to file a request for oral hearing as a separate paper is provided for in 37 CFR § 41.47(b) (see Finding No. 8). As noted above, “[a]n oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal” (see Finding No. 8). Thus, Petitioner presents two reasons to justify suspension or waiver of the separate paper requirement of 37 CFR § 41.47(b) (see Finding No. 5).

Petitioner first argues that Appellants are prejudiced by the Office's denial of an oral hearing Appellants have spent a lot of time and resources on this Appeal and that had they known that they would not be able to argue this Appeal at an oral hearing, then Appellants may not have pursued such an Appeal (*id.*). This argument is unpersuasive. Since an “appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing” (see Finding No. 8), it is not evident why Petitioner’s decision to pursue an appeal would have hinged so strongly on the availability of an oral hearing.

Petitioner further argues that the oral hearing is necessary in this case to adequately respond to the Examiner's rejections (see Finding No. 5). Specifically, Petitioner states that the complexity of the invention, as it relates to intricate electrical circuits, may have been incorrectly characterized as disclosed in the prior art and further incorrectly combined (id.). In addition, Petitioner states that the Examiner's motivation to combine is based on his own conclusory assertion (id.). Thus, Petitioner desires the oral hearing to specifically point out, on the circuit diagram level, the deficiencies in Examiners' assertions regarding the teachings of the prior art and any motivation to combine (id.).


In the interest of justice, the petition under 37 CFR § 1.183 to suspend or waive the requirement to file the request for oral hearing as a separate paper and grant the oral hearing is GRANTED.

SUMMARY

The petition under 37 CFR § 1.181 to reverse the decision denying the oral hearing is DENIED.

The petition under 37 CFR § 1.183 to suspend or waive the requirement of filing the request for oral hearing as a separate paper and grant the oral hearing is GRANTED.

The application will be forwarded to the appropriate personnel for the scheduling of an oral hearing.


Michael Fleming
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences

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